

Application No.: 09/683,795
Amendment dated: March 14, 2005
Reply to Office Action of December 14, 2004
Attorney Docket No.: 21295.41

b.) Remarks

Claims 1-7 and 9-18 are pending in this application. Claims 12-18 are allowed. Claims 1-2, 4-7 and 9-10 are rejected. Claims 3 and 11 are objected to.

Claims 3 and 11 are allowable and have been amended in various particulars as indicated hereinabove to place them in condition for allowance

Turning now to the merits, Claims 3 and 11 were objected to as being dependent upon a rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims. This has been done.

Claims 1-2 and 6-7 were rejected under 35 U.S.C. 103(a) as being unpatentable by Hellmuth *et al.* ("Hellmuth," U.S. Pat. No. 5,795,295) in view of Demandolx *et al.*, "Multicolour analysis and local image correlation in confocal microscopy" ("Demandolx"). Claims 4 and 5 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hellmuth and Demandolx and further in view of Banitt (U.S. Pat. No. 5,963,247) and Lemelson (U.S. Pat. No. 6,400,980). Claims 9 and 10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hellmuth In view of Demandolx and further in view of Rittman, III *et al.* ("Rittman," U.S. Pat. No. 6,575,969). These rejections are respectfully traversed for the following reasons. In all rejections, the Examiner relies on a person having ordinary skill of the art to provide a motivation to combine.

Applicant submits that the Patent Office has not met the burden of establishing a prima facie case of obviousness. The Patent Office is respectfully asked to consider *In re Lee*, in which "the Board of Patent Appeals and Interferences improperly relied upon 'common knowledge and common sense' of person of ordinary skill in the art to find invention of patent application obvious over combination of two prior art references"¹. The Court went on to say: "In its decision on Lee's patent application, the Board rejected

¹ 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

Application No.: 09/683,795
Amendment dated: March 14, 2005
Reply to Office Action of December 14, 2004
Attorney Docket No.: 21295.41

the need for 'any specific hint or suggestion in a particular reference' to support the combination of the Northrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action."²

To place the application in better condition for appeal, the applicant would also like to bring to the Patent Office's attention the ruling that says that "[O]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion or incentive supporting the combination."³ Applicants invite the Examiner to point the column and line numbers where such a teaching or suggestion may be found.

Applicants would like to draw the Examiner's attention to the background of the invention section of Hellmuth, which must be considered in its entirety not only for what it says, but also for what it does not say: "The disadvantage of the disclosed optical technique is that only the surface of the tumor tissue is accessible to optical detection and, as a result, the disclosed optical technique provides no information about the tumor tissue below the surface." (col. 3, lines 9-14). If Hellmuth were to teach or suggest methods of seeing below the surface, other than his own invention, this is where they would be found, yet, he is silent. Neither Demandolx, nor Banitt, nor Lemelson, nor Rittman cure this deficiency.

² Id. at 1434.

³ Carella v. Starlight Archery and Pro Line Co., 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986) (citing ACS Hosp. Syss., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed Cir. 1984).

Application No.: 09/683,795
Amendment dated: March 14, 2005
Reply to Office Action of December 14, 2004
Attorney Docket No.: 21295.41

Applicants believe that the present application is in condition for allowance. A Notice of Allowance is respectfully solicited. Should any questions arise, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,
HOUSTON ELISEEVA LLP

By Maria Eliseeva
Maria Eliseeva
Registration No.: 43,328
Tel.: 781 863 9991
Fax: 781 863 9931

Lexington, Massachusetts 02421
Date: March 14, 2005